REMARKS/ARGUMENTS

The present amendment is a proposed amendment after final rejection, and it is respectfully requested that the amendment not be entered formally.

Claims 1, 16, 37, 41, 43, and 46 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention.

Telephonic Interview

On January 12, 2004, a telephonic interview between Examiner Volper and Marc S. Hanish, Reg. No. 42,626, took place. During the interview, Applicant clarified the arguments made in response to the last office action - namely that the fact that a filename implicitly specifies a file type does not mean that it is obvious to base a determination of which file to receive on the file type. Applicant agreed to amend the claims to make this distinction more clear, and to fax a proposed amendment to the Examiner for review. On January 20, 2004, Examiner Volper telephoned Mr. Hanish and indicated that he was not inclined to allow the case and would like to see more detail about the determination step in order to overcome the obviousness rejection. Applicant disagrees that such detail is necessary to overcome the rejection, and this amendment will describe the basis for that contention.

The First 35 U.S.C. § 103 Rejection

Claims 1-4, 6-8, 10-17, 37, and 39-41 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Klimenko[1] in view of K.R. Sollings, "The TFTP Protocol (Revision 2)" (hereinafter RFC 783) and Bailey[2], among which claims 1, 16, 37 and 41 are independent claims. This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.[3]

Specifically, the Office Action contends that the elements of the presently claimed invention are disclosed in Klimenko, except that Klimenko does not teach that the information used to locate the file is a port address and file type.[4] The Office Action further contends that RFC 783 discloses a TFTP format that includes a filename, and that it is well known in the art that a filename implicitly specifies a file type.

Applicant recognizes that many filenames implicitly specify file types. However, the cited prior art does not teach basing a determination of which file to retrieve on the file type and

[1] U.S. Patent 5,974,547
[2] U.S. Patent 6,185,623
[3] M.P.E.P § 2143.
[4] Office Action ¶4.

port address. The prior art rather bases its determination solely on the file name itself. If the server is aware of the file name (which describes which file to receive), it would be counterintuitive to make a separate determination of which file to retrieve based on the file type and port address. Klimenko already knows which file to get, why figure it out again?

During the telephone interview, Examiner Volper indicated that the server in Klimneko is made aware of the port address of the client.. However, as Applicant pointed out during the interview, Klimenko is still not basing its determination on which file to retrieve on the port address. The port address in Klimenko is used to match up requests with responses, so as not to mix up requests from various clients. There is no evidence that Klimenko would ever even WANT to base its determination on which file to retrieve on either the file type or the port address. The Patent Office's position seems to be that just because the port address and file type are known to the server in Klimenko, that teaches or suggests basing a decision on which file to retrieve on them. However, simply having access to certain information is not equivalent to basing a decision on that information.

Applicant feels the need to explain why this distinction is important. While the distinction itself is contained in the claims (as maintained above), the explanation as to why it is important is not and is merely provided here for illustrative purposes to give this discussion some context. Applicant hopes that through this discussion, the Patent Office will understand why the distinction described above is extremely relevant.

The present application discusses, as an example embodiment, use by a system controller handling router cards connected within a system by a bus (see Specification, page 1, lines 19-20). Router cards are typically hardware devices having very limited memory with little or no processing ability. Thus, router cards are typically "dumb" devices. Therefore, any additional processing or memory usage that an invention requires from a router card would be detrimental - one goal is to keep the router card as "dumb" as possible while still ensuring efficient operation, as this reduces the need for the addition of expensive, power-consuming, and space-consuming components on to the router card (such as additional memory).

One way to further this goal is for the system controller to do most of the work of determining which file to retrieve. Requiring a router card to determine which file to retrieve would necessitate extra processing power or memory. Even having a third device make the determination of which file to retrieve and storing the file name on the router card could take up more memory space than is available on the card, even without requiring additional processing.

Klimenko, on the other hand, deals with a system with a client computer and a server. The client computer anticipated by Klimenko is a Personal Computer (PC). Klimenko essentially assumes a "smart" client - where processing power and memory space is plentiful. Because of this, there are completely separate motivations between the present application and Klimenko. These separate motivations lead to completely separate mechanisms for determining which file to retrieve. In Klimenko, since processing power and memory space on the client is plentiful, it can require that the client send a full name of the file to retrieve (in fact, Klimenko requires that the client send the full location of the file, which may even be longer than a file

name depending upon how file name is interpreted). Since the client has sent the server this information, there is absolutely no motivation in Klimenko for the server to make any determination at all. In Klimenko, the client is "smart", but the server is "dumb" - at least with respect to determining which file to retrieve. The server in Klimenko merely retrieves what it is told to retrieve. Because of that, there is absolutely no reason why Klimenko would make a determination at all - there is no step of determination at the server. It merely follows orders.

During the telephone interview, the Examiner seemed to indicate that the applicant needs to claim specifics as to what substeps are performed during the determination. Applicant maintains, however, that such specifics are not necessary to overcome the cited references. The cited references fail to teach or suggest an element that is present in claim 1. Claims 16, 37, 41, 43, and 46 contain similar elements.

Claims 2-4, 6-8, 10-15, 17, 40, 42, 44-45, and 47-48 are dependent claims. The arguments made above are equally applicable here. The base claims being allowance, the dependent claims must also be allowable.

Request for Allowance

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Request for Entry of Amendment

Entry of this Amendment will place the Application in better condition for allowance, or at the least, narrow any issues for an appeal. Accordingly, entry of this Amendment is appropriate and is respectfully requested.

Respectfully submitted,
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Dated: 1/22/04

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